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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,168	06/13/2001	Benjamin Slotznick	8899-36U1	6779
570	7590	11/10/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			NGUYEN, LEE	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,168

Applicant(s)

SLOTZNICK, BENJAMIN

Examiner

LEE NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 17-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10,17-31 and 33-41 is/are rejected.
- 7) ☒ Claim(s) 4 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-16 and 30-41 in the reply filed on 8/24/2005 is acknowledged.

Information Disclosure Statement

The Ids filed 6/13/01 and 9/28/01 have been considered and recorded in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-8, 30-31 and 33-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldstein (U.S. Patent 5,410,326).

Regarding claim 1, Goldstein teaches a method of using a telephone device (figs. 1-1A and 10) to allow a user to communicate with a remotely located entity (vendor, col. 4, line 48), the telephone device including (i) a button (col. 29, lines 24-25) which facilitates

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communication between the telephone device and the remotely located entity, and (ii) a wireless receiver (27 or 87, fig. 10), the method comprising: (a) an object or a device 61 connected to an object (figs. 1A and 14) emitting a signal containing a telephone number of the remotely located entity (col. 4, lines 44-49 and fig. 22, step 550); (b) the wireless receiver receiving and automatically capturing the signal emitted by the object or the device connected to the object without selection of any buttons on the telephone device (col. 29, lines 16-18, fig. 22, steps 551-552); and (c) the telephone device automatically establishing two-way communication with the remotely located entity upon selection by the user of the button, wherein selection of the button causes the telephone device to automatically dial the telephone number of the remotely located entity (col. 29, lines 22-29).

Regarding claim 2, Goldstein also teaches that the object is a set-top box of a TV system (col. 4, line 56), the method further comprising: (d) the set-top box receiving the telephone number from broadcast signals sent over the TV system, wherein step (a) is performed by the set-top box emitting a signal containing the telephone number of the remotely located entity (col. 30, lines 16-22).

Regarding claim 3, Goldstein further teaches that the telephone device is a wireless telephone device (fig. 10) having a base station 25 in the set-top box (fig. 1A), and the set-top box is hardwired to a telephone outlet 32 (fig. 1A), and wherein step (c) is performed by using the hardwired telephone outlet in the base station of the set-top box

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to establish two-way communication with the remotely located entity (col. 29, lines 25-29).

Regarding claim 5, Goldstein also teaches that the automatic establishment of two-way communication with the remotely located entity in step (c) occurs by: (i) the telephone device automatically dialing the telephone number of the remotely located entity and communicating user identity information to the remotely located entity (col. 33, lines 50-55, caller's ID), and (ii) the remotely located entity using the user identity information to initiate a call to the telephone device (col. 33, lines 50-55).

Regarding claim 6, Goldstein also teaches that the user identity information is the telephone number of the telephone device (caller's ID, col. 33, lines 50-55).

Regarding claim 7, Goldstein further teaches comprising: (d) the user engaging in an audio session with a person or machine at the remotely located entity upon establishing the two-way communication (col. 30, lines 56-59).

Regarding claim 8, Goldstein also teaches that the telephone device includes transceiver circuitry associated with normal telephone communication functions (FM link and telephone interface) which is separate from the wireless receiver 26 (col. 13, lines 5-15 and col. 29, lines 16-18, optical), and the two-way communication in step (c) uses only the transceiver circuitry (col. 29, lines 3-64, bidirectional FM link with telephone

interface 25).

Regarding claim 30, Goldstein teaches a method of using a wireless telephone device (figs. 1-1A and 10) and a set-top box 61 (figs. 1A and 14) of a TV system to allow a user to communicate with a remotely located entity (vendor, col. 4, line 48), the wireless telephone device including a button (col. 9, lines 24-25) which facilitates communication between the telephone and the remotely located entity, the set-top box including a base station 25 (fig. 1A) of the wireless telephone device, the set-top box being in communication with a telephone system 32 and being connected to a television 9 (fig. 1A), the method comprising: (a) the set-top box storing a telephone number (col. 19, lines 28-33) and causes telephone number information to be displayed on the television (col. 12, lines 23-33); and (b) upon selection by the user of the button, the telephone device sending a signal to the set-top box to dial the telephone number that is stored in the set-top box (col. 17, lines 27-31, thereby establishing two-way communication between the telephone device and the remotely located entity via base station and the telephone system (col. 29, lines 15-29).

Regarding claim 31, Goldstein inherently teaches comprising: (c) the set-top box prestoring a listing of telephone numbers corresponding to specified television stations, wherein the telephone number dialed in step (b) is the prestored telephone number of the currently active television channel (col. 5, lines 32-36 and col. 19, lines 4-11, the TV channels (television stations) can also have telephone numbers of their own).

Regarding claim 33, Goldstein also teaches that the establishment of two-way communication with the remotely located entity in step (b) occurs by: (i) the telephone device sending a signal to the set-top box to dial the telephone number of the remotely located entity and communicating user identity information to the remotely located entity, and (ii) the remotely located entity using the user identity information to initiate a call to the telephone device (col. 31, lines 46-58, the telephone number of the user is received at the sponsor party (vendor) for comparison).

Regarding claim 34, Goldstein also teaches that user identity information is the telephone number of the telephone device (col. 31, lines 46-58, the telephone number of the user is received at the sponsor party (vendor) for comparison).

Regarding claim 35, Goldstein further teaches that the user engaging in an audio session with a person or machine at the remotely located entity upon establishing the two-way communication (col. 30, lines 56-59).

Regarding claim 36, Goldstein also teaches that the telephone system 25 is external to the TV system 6 (fig. 1A, col. 7, lines 42-50).

Regarding claim 37, Goldstein also teaches that the telephone system uses the TV system for establishing and maintaining the two-way communication (col. 8, lines 57-61).

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and col. 11, lines 15-40).

Regarding claim 38, Goldstein further teaches that the telephone number information is the telephone number stored at the set-top box (col. 17, lines 27-31).

Regarding claim 39, Goldstein further teaches that the telephone number information is a telephone icon which indicates that the telephone number stored at the set-top box will be dialed upon selection of the button (col. 11, lines 44-59).

Regarding claim 40, Goldstein also teaches that the telephone number information is the telephone number stored at the set-top box and a telephone icon which indicates that the telephone number stored at the set-top box will be dialed upon selection of the button (col. 11, lines 44-59).

Regarding claim 41, Goldstein also teaches comprising: (c) the set-top box receiving the telephone number which is stored in step (a) from broadcast signals sent by the TV system (col. 17, lines 27-31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of DeMont (U.S. Patent 6,351,640).

Regarding claim 9, Goldstein fails to teach that the object is an outdoor sign or billboard.

The art of providing commercial telephone number through an electronic billboard is conventionally well known, as taught by DeMont in col. 6, lines 11-35 and figure 5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine DeMont with Goldstein in order to assist users to initial call with advertiser.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein in view of Yuen (U.S. Patent 6,662,007).

Regarding claim 10, Goldstein fails to teach that the device connected to an object is a wireless transmitter connected to a television, the method further comprising: (d) the television receiving the telephone number from broadcast signals received by the television, wherein step (a) is performed by the wireless transmitter emitting a signal containing the telephone number of the remotely located entity. Yuen teaches a wireless transmitter 14 connected to a television 10 (fig. 1). Yuen further teaches comprising: (d) the television receiving the telephone number from broadcast signals received by the television (col. 2, lines 27-34), wherein step (a) is performed by the wireless transmitter emitting a signal containing the telephone number of the remotely

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located entity (col. 2, lines 17-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yuen with Goldstein in order to facilitate the requirement of positioning the set top box, the television and the telephone jack.

Allowable Subject Matter

Claims 4, 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 4, as dependent on claim 2, the prior art of record fails to teach that the telephone device is a cellular telephone device, and step (c) is performed by using a cellular telephone network to establish two-way communication with the remotely located entity.

Regarding claim 32, as dependent on claim 31, the prior art of record fails to teach that the television station automatically forwarding any received telephone calls to a telephone number of the remotely located entity.

Claims 11-16 are allowed.


Regarding claim 11, the prior art of record fails to teach step c.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is 571-272-7854. The examiner can normally be reached on FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VUONG QUOCHIEN can be reached on 571-272-7902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 11/6/05
LEE NGUYEN
PRIMARY EXAMINER